



UNITED STATES
PATENT AND
TRADEMARK OFFICE

SEP 20 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of :
Vilmos Kéri et al :
Serial No.: 09/578,587 : PETITION DECISION
Filed: April 19, 2000 :
Attorney Docket No.: 5173 :
:

This is in response to applicants' petition under 37 CFR 1.181, filed August 21, 2002, requesting withdrawal of finality of the last Office action.

A review of the recent file history shows that the examiner mailed a Final Office action to applicants on May 1, 2002, in which claims 4, 6 and 11-13 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness; claim 11 was rejected under 35 U.S.C. 102(e) as anticipated by Jekkel et al; and claims 4, 6 and 11-16 were rejected under 35 U.S.C. 103(a) as obvious over Jekkel et al in view of Nakamura et al and alternatively over Nakamura et al in view of Tsujita et al and Endo et al. The rejections were made in the previous Office action and repeated with an appropriate response to applicants' arguments in the Final Office action. Applicants' reference to and reliance upon an affidavit submitted in a parent application (a copy of which was not supplied with the reply) was noted, however the affidavit was not considered with reason for non-consideration given.

Applicants replied to the Office action on June 11, 2002 with a proposed amendment of claims 4, 6, 12 and 13, and replies to the rejections of record with the inclusion of a copy of the affidavit previously relied upon. The examiner prepared and mailed an Advisory Action to applicants on July 19, 2002, however the mailing address thereon was incorrect and the action was eventually returned to the Office as undeliverable. The Advisory Action indicated that the affidavit was not considered as it was presented late without good and sufficient reasons for earlier presentation. The action also responded to applicants arguments regarding the term "the improvement consisting essentially of" and what it actually limited. The Advisory action was subsequently facsimile transmitted to applicants as well as remailed on August 22, 2002, to the correct address.

Applicants then filed this petition seeking review of the finality of the last Office action, consideration of the affidavit since it was of record in the Office in a parent application and not presented late as well as review of a new rejection regarding the term "the improvement consisting essentially of".

Subsequent to a telephone interview with SPE Wityshyn on August 22, 2002, the examiner prepared a new Advisory Action which was mailed August 28, 2002, in which the affidavit was fully considered and commented on as to why it does not overcome the rejections of record. As also noted in the action, applicants' mailing address has been corrected on the Office records. The action further noted that the comments on the phrase "the improvement consisting essentially of" were merely a reply to applicants arguments' as to the claim scope defined by it. As understood by the examiner the phrase limits only the "improvements" in a process or processes having various steps and alternatives, not the known steps.

DISCUSSION

In view of the supplemental Advisory Action which provides a full explanation as to why the affidavit does not overcome the rejections of record and all other supposed errors in the examiner's action having been addressed by the examiner, applicants' request for withdrawal of the finality of the last Office action is moot. It is noted that no new rejections were set forth in the last Office action and that all of the rejections set forth in the last Office action are over the same references and for the same reasons as in the previous Office action. Thus the finality of the last Office action was not improper.

DECISION

Applicants' petition is **DENIED**. The Finality of the last Office action, mailed May 1, 2002, is maintained.

Applicants, however, remain under obligation to file an acceptable reply to the last Office action within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.


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Director, Technology Center 1600